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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,213	10/31/2000	Jonathan M. Smith	062105-0005	9605
9629	7590	10/17/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			MIRZA, ADNAN M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/703,213

Applicant(s)

SMITH ET AL.

Examiner

Adnan M. Mirza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicant's arguments, see Appeal Brief, filed 06/27/2006, with respect to claims 1-24 have been fully considered and are persuasive. The Finality of office Action has been withdrawn.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavner (U.S. 6,366,947) and Peckover (U.S. 6,119,101).

As per claims 1,11,19 Kavner disclosed in a computer network, a method for obscuring user requests for information comprising: routing a user computer request for information, aimed at another network member, to a first cache memory, if the first cache memory contains the requested information, returning the requested information in response to the user request without releasing the user request to the network member; if the first cache memory does not contain the requested information (col. 4, lines 2-18); receiving the requested information from the network member; and storing a copy of the requested information in the first cache memory such that user requests for information that can be satisfied by information stored in the cache memory are not revealed to other network members (col. 4, lines 19-34), and user requests that

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cannot be satisfied by the cache memory are obscured by editing prior to release to other network members (col.14, lines 25-37).

However Kavner did not disclose in detail editing user identity information contained in the request, resulting in an edited request with obscured identity information, releasing the edited request to the network member.

In the same field of endeavor Peckover disclosed enabling the collection of market information, especially data needed to qualify of various kinds of consumer demand, while protecting the particular identity and privacy of consumers. Consumers, because their identity is protected, feel secure in using the system, thereby generating market data as a by product of their shopping activities (col. 14, lines 15-21).

It would have been obvious to one having ordinary skill in the art at the time of invention was made to have incorporated enabling the collection of market information, especially data needed to qualify of various kinds of consumer demand, while protecting the particular identity and privacy of consumers. Consumers, because their identity is protected, feel secure in using the system, thereby generating market data as a by product of their shopping activities as taught by Kavner in the method of Beser to protect consumer identity and private information while gathering market information.

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3. As per claims 2,12,20 Kavner-Peckover disclosed further comprising the step of routing the edited request to a second Cache memory prior to releasing the edited request to the network member; and if the second cache memory contains the requested information, returning the requested information in response to the edited request without releasing the edited request to the network member (Kavner, col. 13, lines 46-57).

4. As per claims 3,13,21 Kavner-Peckocer disclosed further comprising the step of. if the second cache memory does not contain the requested information, further editing the user identity information contained in the edited request prior to releasing the edited request to the network member (Kavner, col. 18, lines 1-9).

5. As per claims 4,14,22 Kavner-Peckover disclosed wherein the computer network is the Internet (Peckover, col. 30, 44-48).

6. As per claims 5,15,23 Kavner-Peckover disclosed wherein the user computer request for information is a Uniform Resource Locator (URL) reference string (Peckover, col. 30, lines 44-48).

7. As per claims 6,16 Kavner-Peckover disclosed wherein the network member is a server computer (Peckover, col. 17, lines 52-57).

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8. As per claims 7,17,24 Kavner-Peckover disclosed wherein the first cache memory is resident on the user computer (Peckover, col. 25, lines 10-20).
9. As per claims 8,18 Kavner-Peckover disclosed wherein the first cache memory is resident on a computer remote from the user computer (Peckover, col. 25, lines 10-20).
10. As per claim 9 Kavner-Peckover disclosed wherein the editing is performed by the user computer (Peckover, col. 27, lines 33-41).
11. As per claim 10 Kavner-Peckover disclosed wherein the editing is performed by a computer remote from the user computer (Peckover, col. 27, lines 33-41).

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (571)-272-3885.
13. The examiner can normally be reached on Monday to Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin Wallace can be reached on (571)-272-6159. The fax for this group is (703)-746-7239.

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14. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-746-7239 (For Status Inquiries, Informal or Draft Communications, please label

“PROPOSED” or “DRAFT”);

(703)-746-7239 (For Official Communications Intended for entry, please mark “EXPEDITED PROCEDURE”),

(703)-746-7238 (For After Final Communications).

15. Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Any response to a final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks Washington, D.C.20231

Or faxed to:

Hand-delivered responses should be brought to 4<sup>th</sup> Floor Receptionist, Crystal Park II,  
2021 Crystal Drive, Arlington, VA 22202.

Adnan Mirza

Examiner



JASON CARDONE  
SUPERVISORY PATENT EXAMINER